

YAMAP0347USBSerial No. 09/525,247**REMARKS**

Upon entry of the present Reply, claims 8, 9, 12, 13, 51 and 52 are under consideration, although claims 8-10, 12-14 and 21-55 are pending, in the present application. Claims 10, 14, 21-50 and 53-55 have been withdrawn from consideration.

Applicants note that support for the amendments of claims 8, 12 and 51, may be found for example, at page 26, lines 7-9 as further explained and supported by the declaration of Mr. Uriu (no specific gap), and for example in Fig. 18 (continuous on one surface and substantially free of discontinuities) of the application as filed. Applicants respectfully submit that the presently claimed invention is fully supported in the application as filed, and that no new matter is contained therein.

Applicants respectfully request reconsideration of the application, withdrawal of the rejections, and allowance of the claims. Applicants respectfully submit that the claims are in condition for allowance and request notice to such effect.

Rejection of Claims 8, 9 12, 13, 51 and 52 Under 35 U.S.C. §103(a)

Claims 8, 9 12, 13, 51 and 52 stand rejected as obvious over Mizoguchi et al., U.S. Patent No. 6,593,841, in view of Takahashi et al., U.S. Patent No. 4,322,698. Applicants traverse this rejection for at least the following reasons.

These claims have been amended to recite that, in the claimed lamination ceramic chip inductor, the magnetic insulation layers contact one another in the area not in contact with the conductive pattern and have no specific gap between the at least one fine, continuous conductive pattern and th pair of magnetic insulation layers, and to recite that each of the at least one continuous conductive pattern is continuous on one surface of one of the magnetic insulation layers, and each of the at least one continuous conductive pattern is substantially free of discontinuities, in addition to the other features of the claims. Applicants respectfully submit that these features, together with the other features of the claims as a whole, fully patentably distinguish

YAMAP0347USBSerial No. 09/525,247

the presently disclosed and claimed invention over the contended combination of Mizoguchi et al. and Takahashi et al.

As admitted in the Office action, Mizoguchi et al. fails to disclose the specific arrangement of the magnetic insulation layers and the conductive patterns. In order to remedy this admitted shortcoming of the disclosure of Mizoguchi et al. with respect to the presently disclosed and claimed invention, the Examiner resorted to citation of Takahashi et al., which the Examiner contends discloses "an inductor device [figure 34] comprising a plurality of conductive patterns [122, 124], each disposed between two magnetic insulation layers [121, 123, 125], wherein the magnetic insulation layer is in contact with the conductive pattern and the magnetic insulation layers contact one another in the areas no in contact with the conductive pattern." Based on the contended combination of the disclosures of Mizocugh et al. and Takahashi et al., the Examiner again in conclusory fashion contended that the claimed invention would have been obvious.

Applicants respectfully traverse the rejections of these claims on the contended basis, in view of the amended claims submitted hereinabove.

Applicants respectfully submit that Takahashi et al. prints a conductive coil with a paste of a Pd-Ag alloy and a binder (see Takahashi et al. at col. 3, lines 41-44). As has been clearly shown in the declarations of Mr. Uriu submitted during previous prosecution of this application, such a printing technique *necessarily* results in the formation of a specific gap between the conductive coil and the magnetic layers. As set forth in the amended claims submitted herein, in the present invention, no such specific gap is formed. This is clearly supported in the specification as filed, and has been shown factually in the declarations of Mr. Uriu. Specifically, as set forth in detail in the previous replies to Office action (filed Dec. 11, 2002, April 10, 2002) and in the Declarations under 37 CFR 1.132 of Eiichi URIU (dated March 7, 2002 and Dec. 11, 2002 submitted with the above-noted replies to Office action), the "no specific gap"

YAMAP0347USBSerial No. 09/525,247

feature of the present invention is significant and would not be achieved by the methods disclosed in Takahashi et al.

Applicants respectfully submit that the contended combination of Mizoguchi et al. in view of Takahashi et al. fails to disclose or suggest the feature of the presently claimed invention, that no specific gap is formed. This feature, together with the other features of the claims as a whole, fully and clearly patentably distinguish the present invention over that of the prior art generally and over the contended combination of Mizoguchi et al. and Takahashi et al. in particular.

Applicants respectfully submit that the amendment of the claims to specify that the conductive pattern is continuous on one surface of one of the magnetic insulation layers, and that each of the at least one continuous conductive pattern is substantially free of discontinuities, further distinguishes over the contended combination of Mizoguchi et al. and Takahashi et al. since in Takahashi et al. the conductive pattern is not continuous on one insulating layer (see, e.g., Figs. 1-13 of Takahashi et al.). As a further example, in Takahashi et al, the conductive pattern is formed by connecting the conductive pattern of both surfaces of the insulating layers in, e.g., Figs. 29-30.

Thus, Applicants respectfully submit that the contended combination of Mizoguchi et al. in view of Takahashi et al. fails to disclose or suggest the feature of the presently claimed invention, that the conductive pattern is continuous on one surface of one of the magnetic insulation layers, and that each of the at least one continuous conductive pattern is substantially free of discontinuities. This feature, together with the other features of the claims as a whole, fully and clearly patentably distinguish the present invention over that of the prior art generally and over the contended combination of Mizoguchi et al. and Takahashi et al. in particular.

Accordingly, having failed to identify all of the features of the presently claimed invention in the prior art, the Examiner has again failed to state a legally correct *prima facie* case of obviousness of Applicants' claims with respect to the prior art. Therefore the rejections should be withdrawn.

YAMAP0347USBSerial No. 09/525,247**Lack of Motivation for Contended Combination of References**

Applicants respectfully submit that the Examiner's contended motivation for making the contended combination of Mizoguchi et al. and Takahashi et al., i.e., that it would have been obvious to use the magnetic insulation layers and conductive patterns arrangement of Takahashi et al. in Mizoguchi et al. "for the purpose of reducing the thickness of the device", fails to provide any basis for the contended combination. For this additional reason, the Examiner again failed to state a *prima facie* case of obviousness. The Examiner provided no source for this alleged motivation, provided no factual basis for how this alleged motivation would have caused a person of ordinary skill in the art to even attempt to make the contended combination of Mizoguchi et al. and Takahashi et al., and utterly fails to satisfy the burden which the Examiner carries under 35 U.S.C. 103, 37 CFR 1.104 and MPEP 706.02(j) and other portions of the MPEP. The Examiner's alleged motivation fails to state what disclosure from either cited reference, or from any other source, would have provided the requisite motivation, and how this would have led to Applicants' claimed invention. Accordingly, the Examiner has failed to state a legally correct *prima facie* case of obviousness of Applicants' claims with respect to the prior art. Therefore the rejections should be withdrawn.

Conclusion

Applicants respectfully submit that Mizoguchi et al. in view of Takahashi et al. fail to disclose or suggest all the features of the presently claimed invention. Accordingly, Mizoguchi et al. in view of Takahashi et al. cannot have rendered obvious Applicants' claimed invention. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejections of claims 8, 9 12, 13, 51 and 52 over Mizoguchi et al. in view of Takahashi et al.

Furthermore, since the generic claims are considered allowable, Applicants respectfully request that all of the withdrawn claims within the scope of the allowable

YAMAP0347USBSerial No. 09/525,247

generic claims, that is, those of claims 10, 14, 21-50 and 53-55 dependent upon or within the scope of the allowable claims, be reinstated into the application and allowed together with claims 8, 9 12, 13, 51 and 52.

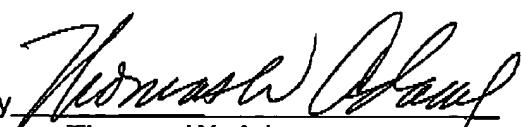
For the foregoing reasons, Applicants respectfully submit that the present application is in condition for allowance. Applicants submit that all indefiniteness issues have been addressed and overcome, and that all obviousness rejections should be withdrawn for the foregoing reasons.

In the event issues remain in the prosecution of this application, Applicants request that the Examiner telephone the undersigned attorney to expedite allowance of the application. Should a Petition for Extension of Time be necessary for the present Reply to the outstanding Office action to be timely filed (or if such a petition has been made and an additional extension is necessary) petition therefor is hereby made and, if any additional fees are required for the filing of this paper, the Commissioner is authorized to charge those fees to Deposit Account #18-0988, Docket No. YAMAP0347USB.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, P.L.L.

Date: January 5, 2005

By 
Thomas W. Adams
Reg. No. 35,047

1621 Euclid Avenue
Nineteenth Floor
Cleveland, Ohio 44115
(216) 621-1113

B:\Adams-Tom\Client Files\YAMA\347B\YAMA347B.ROA6_Jan05.wpd

Page 14 of 14